## **REMARKS**

This Amendment responds to the Office Action dated August 29, 2003 in which the Examiner rejected claims 5, 7, 10-12 and 15-16 under 35 U.S.C. §102(b) and rejected claims 6, 8-10, 13-14 and 17 under 35 U.S.C. §103.

As indicated above, claims 5, 6, 8 and 15-17 have been canceled without prejudice. In addition, claim 7 has been amended to incorporate claim 8 and claims 10-14 have been amended for dependency. Applicants respectfully submit that the amendments are unrelated to a statutory requirement for patentability.

Claim 7 claims a method of manufacturing electronic parts comprising the steps of first, holding a substrate on a surface of a holding jig made of an elastic material, in which at least the surface of the elastic material is adhesive, by the adhesive strength of the surface. Next, an element is mounted and electrically connected on the substrate while the substrate is held on the surface of the elastic material. Finally, ultrasonic waves are applied to the bonding portion at which the electrical connection is performed.

Through the method of the claimed invention holding a substrate on a surface of an elastic material by the adhesive strength of the surface, mounting and electrically connecting an element on the substrate and then applying ultrasonic waves to the bonding portion at which the electrical connection is performed, as claimed in claim 7, the claimed invention provides a method of manufacturing electronic parts which prevents the generation of electrostatic charges. The prior art does not show, teach or suggest the invention as claimed in claim 7.

Claims 7, 10-12 and 15-16 were rejected under 35 U.S.C. §102(b) as being anticipated by *Kazuhiko et al.* (Japanese reference JP 07-022795).

Kazuhiko et al. appears to disclose a SUS-made metal flat board 2 which is coated uniformly with an adhesive silicone rubber layer 1. A thin board 3 is flattened and fixed to the metal flat board 2 by the adhesive force of the adhesive silicone rubber layer 1. As the flat board to be used, a metal flat board, a plastic flat board, a ceramic flat board or the like is enumerated.

Thus, *Kazuhiko et al.* merely discloses fixing a board 3 to a board 2 by an adhesive force of a rubber layer 1. Nothing in *Kazuhiko et al.* shows, teaches or suggests applying ultrasonic waves to a bonding portion at which an electrical connection is performed as claimed in claim 7. Rather, *Kazuhiko et al.* merely discloses fixing a board 3 to a board 2 by a rubber layer 1.

Also, *Kazuhiko et al.* merely discloses fixing a thin board 3 to a metal flat board 2 by an adhesive force of an adhesive silicone rubber layer 1. Nothing in *Kazuhiko et al.* shows, teaches or suggests mounting and electrically connecting an element on a substrate while the substrate is held on a surface of a holding jig made of an elastic material as claimed in claim 7. Rather, *Kazuhiko et al.* merely discloses fixing a thin board 3 to a flat board 2 by an adhesive force of a rubber layer 1.

Since nothing in *Kazuhiko et al.* shows, teaches or suggests a) applying ultrasonic waves to a bonding portion at which electrical connection is performed and b) mounting and electrically connecting an element on a substrate while the substrate is held on a

surface of a holding jig made of an elastic material as claimed in claim 7, it is respectfully requested that the Examiner withdraws the rejection to claim 7 under 35 U.S.C. §102(b).

Claims 10-12 depend from claim 7 and recite additional features. It is respectfully submitted that claims 10-12 would not have been anticipated by *Kazuhiko et al.* at least for the reasons as set forth above. Therefore, it is respectfully requested that the Examiner withdraws the rejection to claims 10-12 under 35 U.S.C. §102(b).

Claims 9 and 10 were rejected under 35 U.S.C. §103 as being unpatentable over *Kazuhiko et al.* in view of *Oehmke* (U.S. Patent No. 4,098,945). Claim 13 was rejected under 35 U.S.C. §103 as being unpatentable over *Kazuhiko et al.* in view of Applicants admitted prior art and claim 14 was rejected under 35 U.S.C. §103 as being unpatentable over *Kazuhiko et al.* in view of *Matsushita* (Japanese Reference 11-045912).

As discussed above, since nothing in *Kazuhiko et al.* shows, teaches or suggests the primary features as discussed above, it is respectfully submitted that the combination of the primary reference of *Kazuhiko et al.* with the secondary references will not overcome the deficiencies of the primary reference. Therefore, it is respectfully requested that the Examiner withdraws the rejection to claims 9, 10, 13 and 14 under 35 U.S.C. §103.

As indicated above, since claim 8 was incorporated into claim 1, Applicants respectfully submit that there are no new issues for the Examiner to consider.

Thus it now appears that the application is in condition for reconsideration and allowance. Reconsideration and allowance at an early date are respectfully requested.

Should the Examiner find that the application is not now in condition for allowance, applicants respectfully request the Examiner enters this Amendment for purposes of appeal.

Application No. <u>09/689,774</u> Attorney's Docket No. <u>018976-181</u> Page 8

If for any reason the Examiner feels that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact, by telephone, the Applicants' undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this case.

In the event that this paper is not timely filed within the currently set shortened statutory period, Applicants respectfully petition for an appropriate extension of time. The fees for such extension of time may be charged to our Deposit Account No. 02-4800.

In the event that any additional fees are due with this paper, please charge our:

Deposit Account No. 02-4800.

By:

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

Date: December 1, 2003

Ellen Marcie Emas Registration No. 32,131

P.O. Box 1404 Alexandria, Virginia 22313-1404 (703) 836-6620